

REMARKS

The claims were amended in accordance with the marked-up amendments, above. The amendments are being made to clarify the invention and to focus the claims on those aspects of the invention which are a commercial priority to the assignee. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

The Office Action rejected claims 1-39 under 35 U.S.C. § 103 as being obvious over Henson (U.S. Patent 6,167,383) in view of Dell (Article: Dell Uses Internet to Offer Small Business Customers Personalized Sales and Educational Programs, *Business Editors & Technology Writers*, Business Wire, New York; July 20, 1998). Applicants traverse all such rejections because a *prima facie* case of obviousness has not, and cannot be, established with respect to the pending independent claims (i.e., claims 1, 18, and 37). The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. To establish a *prima facie* case of obviousness, as specified in MPEP § 2143, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success.

Applicants traverse the obviousness rejections because the cited references do not teach or suggest all the claim limitations (see MPEP § 2143.03). Multiple limitations recited in claims 1, 18, and 37 the only pending independent claims, are not taught or suggested in Henson or Dell. Regarding independent claim 1, Henson and Dell fail to teach or suggest a method of optimizing a product that includes a base product, including the combination of: obtaining an identification of a user and a preliminary designation of a product; said identification identifying a user profile that is uniquely associated with said user, the user profile including at least one characteristic corresponding to said user; providing a formatted display that includes a set of content related to said product and a format, the set of content and format determined by a characteristic in said user profile; updating, based on a response by the user the at least one characteristic in said user profile to create an updated user profile; and a component associated with said base product when said response includes a selection of an option from a different set of options associated with said component; storing the updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user and repeating the steps at least once to optimize the product.

Regarding independent claim 18, Henson and Dell similarly fail to suggest the currently recited computer readable memory for directing a computer to optimize a product that includes a base product, including the combination of: a user profile

database stored in said memory, each profile in said user profile database being uniquely associated with a different user and including a characteristic that corresponds to said user; and an advisor module for helping a user optimize said product, said advisor module including executable instructions, said executable instructions including instructions for obtaining an identification of said user and a preliminary designation of said product, said identification identifying a user profile associated with said user that includes at least one characteristic corresponding to said user in said user profile database, wherein said instructions for obtaining an identification further include instructions for creating said user profile when it does not exist in said user profile database, instructions for providing a formatted display that includes a set of content related to said product, the set of content and the format determined by a function of a characteristic in said user profile, instructions for updating the at least one characteristic in said user profile to create an updated user profile, and a component associated with said base product when said response includes a selection of an option from a different set of options associated with said component; storing the updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user; and instructions for repeating the steps at least once to optimize said product.

Regarding independent claim 37, Henson and Dell fail to teach or suggest a method of optimizing a product that includes a base product, including the combination of: obtaining an identification of a user and a preliminary designation of a product; said identification identifying a user profile that is uniquely associated with said user, the user profile including at least one characteristic corresponding to said user; providing a formatted display that includes a set of content related to said product and a format, the set of content and format determined by a characteristic in said user profile; updating, based on a response by the user the at least one characteristic in said user profile to create an updated user profile; and a component associated with said base product when said response includes a selection of an option from a different set of options associated with said component; storing the updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user; repeating the steps at least once to optimize the product; and providing automated assistance at the request of said user.

Henson and Dell do not teach or suggest updating at least one characteristic in a user profile to create an updated user profile and storing the updated user profile to determine the set of content and format of the formatted display for a subsequent presentation made to the user. Henson fails to teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to the user. Henson only describes a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set. (See Abstract). The customer is identified as being in a particular customer set according to the link the customer executed to get into the store (See Col. 14, lines 4 through 34). Henson does not teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to said

user. Further, Dell fails to teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to the user. Dell only describes a personalized web site that keeps track of a customer's purchase and service history. (See Page 2). Dell does not teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user.

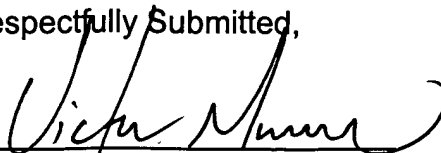
It should be noted that the foregoing is not an exhaustive list of claimed features not taught or suggested by the references of record, and that further limitations are believed to be novel and non-obvious over Henson and Dell.

Beyond the shortcoming with respect to all claim limitations being taught or suggested, a *prima facie* case of obvious has not been, and cannot be, established because there is no suggestion or motivation to modify the combined reference teachings (see MPEP § 2143.01). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Neither Henson or Dell suggest or motivate the combination as currently recited in claims 1, 18, and 37. Without the requisite teaching, suggestion or motivation, *prima facie* case of obvious cannot be established. In addition, there is no reasonable expectation of success in any such combination (see MPEP § 2143.02), thus further establishing that a *prima facie* case of obvious has not been, and cannot be, established.

Accordingly, the three remaining independent claims (*i.e.*, claims 1, 18, and 37) overcome the rejection of record and are in a condition for allowance. Beyond the foregoing shortcomings with respect to the independent claims, Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

Based on the foregoing all pending claims are in a condition for allowance. Accordingly, Applicant submits that all pending claims overcome the rejections presented in the Office Action, and respectfully requests reconsideration and a notice of allowance.

Respectfully Submitted,



Victor C. Moreno (Reg. No. 40,732)
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 651-6812

Certificate of Mailing

The undersigned certifies that this correspondence was deposited with the U.S. Postal Service with sufficient postage as first class mail and addressed to "Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on March 15, 2005

